

CASE 4-20039C

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I hereby certify that this paper entitled <u>SUPPLEMENTAL RESPONSE TO RESTRICTION REQUIREMENT</u>		
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Hesna J. Pfeiffer	<i>Hesna J. Pfeiffer</i>	January 29, 2003
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IN RE APPLICATION OF

Art Unit: 1647

NICO CERLETTI

Examiner: D. Romeo

GROUP 1600

APPLICATION NO: 09/813,271

FILED: MARCH 20, 2001

FOR: NEW PROCESS FOR THE PRODUCTION OF BIOLOGICALLY  
ACTIVE PROTEIN

OFFICIAL

Assistant Commissioner for Patents  
Washington, D.C. 20231SUPPLEMENTAL RESPONSE TO RESTRICTION REQUIREMENT

Sir:

The courtesy of the Examiner in discussing this case on January 29, 2003 is appreciated. The undersigned attorney had realized that the election to the restriction requirement, as answered in the response dated January 15, 2003, was incorrect. Accordingly, the undersigned called to discuss the possibility of changing the election by supplemental paper, with the examiner. As he was amenable to the change, the instant supplemental paper was prepared and is being filed. This paper changes the election of species to the TGF- $\beta$ 3 rather than the TGF- $\beta$ 2 made in the earlier paper.

The Examiner had issued a restriction requirement dated December 16, 2002, response to which was due January 16, 2003. This paper is a supplement to the response filed January 15.

The restriction requirement divided the claims of the case into a two-way grouping:

- I 19-25, drawn to a process for the production of TGF- $\beta$ 2, and
- II 19-25, drawn to a process for the production of TGF- $\beta$ 3.

Election is made with traversal, to the subject matter of Group II, claims 19-25, to a process for the production of TGF- $\beta$ 3, which is also the elected species. All claims are readable on this invention.

The restriction requirement is traversed. The Applicants respectfully disagree with the characterization of the Office that has divided the subject matter of the present application into the above-identified groups, and traverse the restriction requirement entered by the Office.

This case is a continuation of USSN 09/316,724, filed 5/21/1999, now abandoned. In the prosecution of that parent, Applicants had advanced the prosecution, but in the response to the Final Rejection in that case, the Examiner had not permitted the entrance of the claims which are pending in this case. However, the objection to the claims admissibility was not predicated on the presence of two inventions, but merely, that the revised claim language presented new issue necessitating an expanded search. Accordingly, Applicants filed the instant application with the revised claims. All the claims in the Response after Final from the immediate parent are in this application.

In any of the predecessor applications, no restriction requirements were made, and the subject matter encompassed both the (TGF- $\beta$ 2) and the  $\beta$ 3 (TGF- $\beta$ 3) products. It is emphasized that the process for making each, whether (TGF- $\beta$ 2) or  $\beta$ 3 (TGF- $\beta$ 3), is the same. The starting materials only differ. The Examiner can readily search both inventions. It is also pointed out that a voluminous search and the prior art references from both parent applications and any corresponding foreign applications have been cited in the instant application.

The Applicants contend the subject matter of the individual Groups is interrelated and shares common subject matter. The division of the subject matter is believed to place an unreasonable burden on Applicants. A single unified search of the subject matter of all the Claims has been already performed satisfactorily centered about the subject matter of the Groups I and II claims. It is believed that such a search would be of a suitable scope, and may be performed without being unduly burdensome on the part of the Office. Accordingly, reconsideration of the Restriction Requirement entered is solicited, and a single-coextensive search of the subject matter of the claims requested. An action upon the merits of all of the outstanding Claims is anticipated in the next communication to Applicants.

The Examiner would also appear to have to search both groups II and I as defined within the restriction requirement to examine the application.

To further the prosecution of this application, Applicant's attorney provides the following discussion of the closest prior art and issues as most recently submitted in the immediate parent application.

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